

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

In the Final Office Action dated November 12, 2004, the Examiner rejected claims 1, 2, 7, 16-18, 21, and 23, under 35 U.S.C. §103(a), as being unpatentable over Arai '930 (Unexamined Jap. Pat. No. 8-24930) in view of Vazvan '814 (WO 96/13814) O'Mahony et al. (*Electronic Payment Systems*), Martineau '226 (U.S. Patent No. 5,915,226), and Ramachandran'323 (U.S. Patent No. 6,386,323); rejected claim 20, under 35 U.S.C. §103(a), as being unpatentable over Arai '930 in view of Vazvan '814, O'Mahony et al., Martineau '226 and Yacobi '138 (U.S. Patent No. 5,878,138); and rejected claim 26, under 35 U.S.C. §103(a), as being unpatentable over Arai '930 in view of Vazvan '814, O'Mahony et al., Martineau '226 and Pitroda'038 (U.S. Patent No. 5,590,038).

By this Amendment, Applicants have cosmetically amended claim 1 for clarity. Applicants submit that the substance of the claimed subject matter has not been changed nor has any new matter been introduced. As such, claims 1-21 and 23-26 are once again presented for examination of which claim 1 remains the sole independent claim.

Applicants respectfully traverse the prior art rejections, under 35 U.S.C. §103(a), for the following reasons:

I. Prior Art Rejections of Claim 1 Under §103(a).

In the Final Office Action, the Examiner asserted that the grouping of Arai '930, Vazvan '814, O'Mahony et al., Martineau '226, and Ramachandran'323 teach the combination of features recited by claim 1. Applicants strongly disagree.

Independent claim 1, as amended, sets forth a financial transaction method between a customer and a terminal, comprising, *inter alia*:

(a) transmitting, from an identification module of a mobile radio telephone of said customer, a customer identification, via a wireless interface between said identification module and said terminal, without an intermediate transceiver, to a wireless transceiver of said terminal, wherein

(i) said mobile radio telephone is employed in a mobile radio network and comprises a mobile device and said identification module and wherein said identification module is removable and stores at least the customer identification and a monetary amount . . .

First, Applicants point out that the Ramachandran'323 reference used to allegedly render claim 1 unpatentable, claims priority from Provisional Appln. No. 60/108,340, filed on Nov. 13, 1998. Applicants remind the Examiner that the present application claims priority from Swiss Appln. No. 1564/97, filed on June 27, 1997; and PCT Appln. No. PCT/CH98/00282, filed on June 29, 1998. (*See, Declaration*, filed on December 27, 1999). The U.S. filing of the present application included a certified translation of PCT Appln. No. PCT/CH98/00282, as evidenced by the verification statement executed on November 22, 1999, attached herewith. In addition, the Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495, also attached, clearly states that the translation of the PCT application was indeed received by the USPTO. As such, Applicants have proven a date of invention that is at least June 29, 1998, which corresponds to the filing date of PCT Appln. No. PCT/CH98/00282. In so doing, PCT Appln. No. PCT/CH98/00282 clearly predates the filing of Provisional Appln. No. 60/108,340 and the Ramachandran'323 reference cannot reasonably be applied as prior art in this case.

Second, even if Ramachandran'323 could hypothetically qualify as prior art against this application, the combination of Arai '930, Vazvan '814, O'Mahony et al., Martineau '226, and Ramachandran'323 clearly fall short of teaching the combination of features as recited by claim 1. In particular, the Ramachandran'323 reference, which is errantly used by the Examiner to meet the wireless limitation of claim 1, discloses the use of a screen 68 in conjunction with a self-service dispensing machine. Ramachandran'323 merely states that screen 68 may be turned on or presented in response to sensing the presence of a user adjacent to the machine *by way of a proximity-type sensing device, such as, infrared, optical, or sonic type* or in response

to sensing the user touching the machine or lifting the fuel nozzle. (See, Ramachandran'323: col. 9, lines 17 – 25; FIG. 3).

It should be appreciated that the use of a “proximity-type sensing device,” whether it employs infrared or other detection schemes, has nothing to do with transmitting customer identification from a mobile radio telephone identification module. In fact, there is nothing in Ramachandran'323 that remotely suggests directly transmitting anything from a mobile radio telephone – much less transmitting customer identification from the mobile radio telephone identification module via a wireless interface between the identification module and the terminal without an intermediate transceiver, as required by claim 1.

Equally important is the fact that the primary reference, Arai '930, is directed to an automatic vending machine 5 system that employs a mobile telephone 7 and a corresponding radio communication network to effect a purchase. The disclosed system operates under two communication modes: (a) a first communication mode when the mobile telephone is in proximity with the vending machine; and (b) a second communication mode when the mobile telephone is far from the vending machine. (See, Arai '930: para. [0022]). Under both of these communication modes, however, the Arai '930 reference clearly states that *the buyer establishes a telephonic call to the vending machine* in which call originating source information is included in the transmitted information signal. (See, Arai '930: para. [0023]). It will be appreciated that to establish a telephonic call by a mobile telephone set, necessarily requires the use of an intermediate transceiver, such as, for example, a base station or a repeater station.

By virtue of only disclosing the use of a telephonic call to convey user identification information, the Arai '930 reference clearly teaches away from transmitting customer identification from the mobile radio telephone identification module via a wireless interface between the identification module and the terminal without an intermediate transceiver, as required by claim 1.

Applicants further submit that the Arai '930 reference cannot be combined with any reference that may possibly disclose the conveyance of customer identification

information via a direct wireless link, as such a feature is antithetical to the manner in which the Arai '930 system operates. And to merely say that “a cell phone is shown to be a value-bearing device” and that “modifying the cell phone to include an alternative and equivalent wireless technique would be obvious,” without identifying evidence in Arai '930 that suggests such a modification, is simply not proper. (*See, Final Office Action*, page 5). Such an assertion can only be based on impermissible hindsight.

Regarding the application of the Vazvan '814 reference to allegedly meet the removable identification module limitation, Applicants point out that Vazvan '814 discloses the use of a portable terminal 1 SIM card 30 containing user identity information. Like the Arai '930 system, the Vazvan '814 system clearly teaches that the user identity information is transmitted to the wireless communication network 4 for user confirmation. (*See, Vazvan '814*: page 3, lines 30-33). As such, the Vazvan '814 system is incapable of transmitting customer identification from the mobile radio telephone identification module via a wireless interface between the identification module and the terminal without an intermediate transceiver, as required by claim 1.

Moreover, the combination of Arai '930 and Vazvan '814 is also improper. The Arai '930 system specifically includes a charge collecting means where billing information and the mobile telephone number, which serves as the customer identification, are stored and tallied for a given period. (*See, Arai '930*: para. [0028]). As such, there is absolutely no motivation in Arai '930 to include a removable card for the same purpose of identifying the user since this would be redundant. In addition, incorporating a removable card for the purpose of charging the user would render the Arai '930 charge collecting means purposeless. Therefore, it is, at best, unreasonable to assert that the Arai '930 reference somehow suggests or justifies such a combination.

Finally, Applicants remind the Examiner that in the Interview Summary of September 8, 2004, the Examiner clearly acknowledged that replacing the term “contactless” with “wireless” so as to imply direct wireless communication between the handset and vending machine “without obstruction, separate and unsupported by a parallel cellular phone infrastructure” overcomes the prior art. (*See, Interview*

Summary, Continuation Sheet). Although it is certainly within the Examiner's purview to change his position upon discovering prior art that is on point, that is certainly not the case here. None of the references asserted by the Examiner cure the deficiencies of the Arai '930 reference.

For at least these reasons, Applicants respectfully submit that the applied references, whether taken alone or in any combination, do not teach the combination of features recited by independent claim 1. Accordingly, claim 1 is patentable over these references. In addition, because claims 2-21 and 23-26 depend directly or indirectly from claim 1, claims 2-21 and 23-26 are patentable by virtue of their dependency as well as for their additional recitations.

II. Conclusion.

All matters having been addressed and in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicants submit that the entry of this Amendment is proper under 37 C.F.R. §1.116 as the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not require any further consideration; (c) places the application in better form for an appeal, should an appeal be necessary.

Applicants' Counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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